

## **REMARKS**

**[0003]** Applicant respectfully requests reconsideration and allowance of all of the claims of the application. Claims 1-20 and 26-38 are presently pending. Claims amended herein are 1, 7-12, 20, 26, and 36-38. Claims withdrawn or cancelled herein are 21-25 and 39-43. New claims added herein are none.

### **Statement of Substance of Interview**

**[0004]** The Examiner graciously spoke with me—the undersigned representative for the Applicant—on May 17, 2007. Applicant greatly appreciates the Examiner’s willingness to talk. Such willingness is invaluable to both of us in our common goal of an expedited prosecution of this patent application.

**[0005]** During the interview, we discussed how to overcome the §101 and §112 rejections and how the claims differed from the cited art, namely Pintsov. Without conceding the propriety of the rejections and in the interest of expediting prosecution, I also proposed several possible clarifying amendments.

**[0006]** The Examiner was receptive to the proposals, and I understood the Examiner to indicate that the discussed clarifying claim amendments appeared to distinguish over the cited art of record. For example, the Examiner indicated that clarification regarding mathematical expressions distinguished the independent claims 1, 12, and 26 over the cited art, namely Pintsov. However, the Examiner indicated that he would need to review the cited art more carefully and/or do another search and meet with his SPE.

**[0007]** Applicant herein amends the claims in the manner discussed during the interview. Accordingly, Applicant submits that the pending claims are allowable over the cited art of record for at least the reasons discussed during the interview.

#### **Formal Request for an Interview**

**[0008]** If the Examiner's reply to this communication is anything other than allowance of all pending claims, then I formally request an interview with the Examiner. I encourage the Examiner to call me—the undersigned representative for the Applicant—so that we can talk about this matter so as to resolve any outstanding issues quickly and efficiently over the phone.

**[0009]** Please contact me or my assistant to schedule a date and time for a telephone interview that is most convenient for both of us. While email works great for us, I welcome your call to either of us as well. Our contact information may be found on the last page of this response.

#### **Formal Matters**

**[0010]** The Examiner refers to claims 11, 20, 28, 29, 37, and 38 as independent claims. Herein, Applicant notes that each of these claims depends from a previous claim, and therefore is properly a dependent claim.

**[0011]** The fourth paragraph of 35 U.S.C. §112 requires “a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed.” Claims 11, 20, 28, 29, 37, and 38 satisfy this statutory requirement.

**[0012]** Often this format raises an initial concern because the preambles of the dependent claims differ from the base claims. However, the present dependent claims also comply with a format approved by the Board of Patent Appeals and Interferences in *Ex parte Adrianus P.M.M. Moelands*, 3 USPQ2d 1474 (PTO Board of Pat App and Int 1987). In *Moelands*, the Board upheld as appropriate the following dependent claim to a data transmission system:

11. A data transmission system comprising:  
at least two of the data transmission stations of claim 10;  
a clock bus interconnecting the clock terminals of the stations; and  
means which maintain the clock bus at the second voltage level in the  
absence of forcing by the stations.

**[0013]** Although the preamble in *Moelands*' claim 11 to a “data transmission system” is different than the preamble in claim 10 to a “data transmission station”, the Board held that this dependent claim format satisfies the statutory requirements of both the second and fourth paragraphs of 35 U.S.C. §112.

**[0014]** Accordingly, claims 11, 20, 28, 29, 37, and 38 are in an acceptable dependent format and are in condition for allowance.

### **Claim Amendments and Additions**

**[0015]** Without conceding the propriety of the rejections herein and in the interest of expediting prosecution, Applicant amends claims 1, 8, 10-12, 20, 26, and 36, herein. Applicant amends claims in accordance with our telephone discussion with the examiner to overcome §101 and §112 rejections. Such amendments are made to expedite prosecution and quickly identify allowable subject matter. Such amendments are merely intended to clarify the claimed features, and should not be construed as further limiting the claimed invention in response to cited prior art.

**[0016]** Several of the claims are amended to clarify that the result reported by the claim protects digital media. Support for protecting digital media, such as software, which is available via compact disk, floppy disk, LAN, WAN, and the Internet, is provided at least in the section titled "Product Identification (PID) Code" of the Specification (pp. 6-7, ll. 14-10, and Fig. 4).

**[0017]** Claim 37, as amended, is presented in product-by-process form as permitted by MPEP 2173.05(p) § I.

### **Substantive Matters**

#### **Claim Rejections under § 112**

**[0018]** Claims 1-20 and 26-38 are rejected under 35 U.S.C. § 112, 2<sup>nd</sup> ¶. In light of the discussion in the aforementioned interview and the amendments presented herein, Applicant submits that these rejections are moot. Accordingly, Applicant asks the Examiner to withdraw these rejections.

**[0019]** Additionally, regarding the § 112, 2<sup>nd</sup> ¶ rejections of claims 2-11 and 13-25, for recitation of “a medium as recited . . .” Applicant thanks Examiner Gee for its re-characterization as an objection, however in the telephone conference, I explained why I saw no informality or lack of clarity that needed correction. The Examiner indicated that he understood my explanation, but would prefer that the terminology be changed. The following is a full explanation of why I believe that no change is necessary in this regard.

**[0020]** All of these claims are dependent. Applicant submits that the subject of each dependent claim is a separate claimed invention. Although a dependent claim refers back to a base claim to provide a base definition of the subject, the subject itself is fresh and new.

**[0021]** For example, if the reader assumes that a hypothetical independent claim 1 defines a subject Z in the preamble, then a claim dependent therefrom may begin in following proper formats:

- 2. A Z as recited in claim 1, wherein...
- 3. A Z in accordance with claim 1, wherein...
- 4. The Z of claim 1, wherein...

Language such as “as recited in claim 1” or “in accordance with claim 1” defines subject Z (of the dependent claims) in a manner that is clear and definite. Applicant submits that use of “the” instead of “a” does not make the claims more clear or more definite.

**[0022]** The following persuasive references are provided to support Applicant’s position. Specifically, they are (1) examples of patents using the same or similar wording; (2) a quote from well-known and highly respected treatise on claim drafting;

and (3) a quote from the MPEP (which specifically refers to multiple dependent claims, but the fundamental basis is the same for singular dependent claims):

(1) Examples of issued patents using the same or similar wording for dependent claims: 5764526; 5734652; 5721781; 5600368; 5551024; 5512921; 5387976; 5974483; 5933838; and 6,006,330.

(2) Faber, Practicing Law Institute (PLI), *Landis on Mechanics of Patent Claim Drafting*, Fourth Edition, §11 (1997) (pp. II-15 in Faber, Rel. #2, 12/98) (emphasis added) on dependent claims states the following:

This is the single dependent claim with which practitioners are most familiar. Examples include:

The shaker of claim 1, wherein...

The shaker according to claim 1, wherein...

*A shaker as claimed in claim 1, wherein...*

The shaker as in claim 1, in which...

The words used to establish claim dependency in the preamble of the claim are a matter of choice, so long as the dependency of the claim is clearly set forth.

(3) MPEP 608.01(n) "Dependent Claims" (emphasis added) states the following:

A. Acceptable Multiple Dependent Claim Wording

Claim 5. *A gadget according to claims 3 or 4, further comprising ---*

Claim 5. *A gadget as in any one of the preceding claims, in which ---*

Claim 3. *A gadget as in either claim 1 or claim 2, further comprising ---*

Claim 4. *A gadget as in claim 2 or 3, further comprising ---*

Claim 16. *A gadget as in claims 1, 7, 12, or 15, further comprising ---*

**[0023]** Accordingly, as per the dependent claims in question here, Applicant respectfully requests that the objections be withdrawn. If these objections are maintained, Applicant requests further clarification as to why these claims are considered unclear and indefinite.

#### **Claim Rejections under § 101**

**[0024]** Claims 37 and 38 are rejected under 35 U.S.C. § 101. In light of the amendments presented herein, Applicant respectfully submits that these claims comply with the patentability requirements of § 101 and that the § 101 rejections should be withdrawn. The Applicant further asserts that these claims are allowable. Accordingly, Applicant asks the Examiner to withdraw these rejections.

**[0025]** If the Examiner maintains the rejection of these claims, then the Applicant requests additional guidance as to what is necessary to overcome the rejection.

#### **Claim Rejections under §§ 102 and/or 103**

**[0026]** Claims 1-20 and 26-38 are rejected under 35 U.S.C. § 102 and/or § 103. In light of the amendments presented herein and the decisions/agreements reached during the above-discussed Examiner interview, Applicant submits that these rejections are moot. Accordingly, Applicant asks the Examiner to withdraw these rejections.

### Dependent Claims

**[0027]** In addition to its own merits, each dependent claim is allowable for the same reasons that its base claim is allowable. Applicant requests that the Examiner withdraw the rejection of each dependent claim where its base claim is allowable.

### Conclusion

**[0028]** All pending claims are in condition for allowance. Applicant respectfully requests reconsideration and prompt issuance of the application. If any issues remain that prevent issuance of this application, the Examiner is urged to contact me before issuing a subsequent Action. Please call/email me or my assistant at your convenience.

Respectfully Submitted,

Dated: 06/18/2007

By: 

Beatrice L. Koempel-Thomas  
Reg. No. 58,213  
(509) 324-9256 x259  
bea@leehayes.com  
[www.leehayes.com](http://www.leehayes.com)

My Assistant: Carly Taylor  
(509) 324-9256 x264  
[carly@leehayes.com](mailto:carly@leehayes.com)